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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,291	09/11/2003	Olaf Vancura	1482/324(a)	5365

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EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/660,291	<b>Applicant(s)</b> VANCURA, OLAF	
	<b>Examiner</b> Scott E. Jones	<b>Art Unit</b> 3713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/11/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.
2. The oath or declaration is defective because:
  - It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.
  - It does not identify the citizenship of each inventor.
  - It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.
  - It was not executed in accordance with either 37 CFR 1.66 or 1.68.
  - The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

### ***Drawings***

3. The drawings are objected to because:
  - Page 9, line 10, refers to gaming terminal (1240), however, the gaming terminal (1200) is shown in figure 12 along with game display (1240).

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- Page 10, line 21 refers to gaming terminal (1210), however, the gaming terminal (1200) is shown in figure 12 along with gaming controller (1210).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Objections*

5. Claim 5 is objected to because of the following informalities:

- In claim 5, line 3, applicant should use formal language to recite the elements of the claim. In particular, the examiner recommends applicant change "them" to "said symbols".

Correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 3, applicant claims randomly entering free play mode from the normal play mode, and randomly entering the normal play mode from the free play mode, such that the frequency of entering the free play mode from the normal play mode is less than the frequency of entering the normal play mode from the free play mode. The examiner believes, as claimed, that there would be a one to one correspondence between the frequency of entering the normal play mode from the free play mode and vice versa. Therefore, having a frequency of entering the free play mode from the normal play mode being less than the frequency of entering the normal play mode from the free play mode would be impossible. Furthermore, the examiner believes applicant may have intended to claim that a player would spend more play time or number of turns in the normal play mode than in the free play mode as described on page 14, line 18-page 15, line 29 of the specification.

Claim 4 inherits the deficiency of claim 3 by dependency.

8. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as being a single step method claim. The clause simply recites a single step in a process. A process claim requires that a series

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of steps be performed. Therefore, Claim 5 is a "single step method" claim that requires additional steps to be placed in proper form. Please see MPEP § 2164.08(a).

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 5, 7, 8, 9, 25, 26, 27, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 5 recites the limitation "the symbols" in line 2. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 5 recites the limitation "the outcome" in line 2. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 5 recites the limitation "the base game" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 5 recites the limitation "the selection" in line 2. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 7 recites the limitation "the normal-play-mode award" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 8 and 9 inherit the deficiencies of claim 7 by dependency.

16. In claim 25, lines 3-4, the limitation, "a wager/award input/output for receiving a wager from a player to initiate said base game;" is unclear. Although, the claim recitation "a wager input for receiving a wager from a player to initiate said base game" is somewhat clear, "a award output for receiving a wager from a player to initiate said base game" is not.

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Claims 26-28 inherit the deficiencies of claim 25 by dependency.

17. In claim 29, lines 3-4, the limitation, "a wager/award input/output for receiving a wager from a player to initiate said casino game;" is unclear. Although, the claim recitation "a wager input for receiving a wager from a player to initiate said casino game" is somewhat clear, "a award output for receiving a wager from a player to initiate said casino game" is not.

18. The items noted hereinabove are not meant to be an exhaustive list of all informalities with the claims. Applicant should review the entire specification, including the claims, and submit corrections for all informalities including those noted above.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1, 2, 5, 6, 7, and 9-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Slomiany et al. (U.S. 6,159,098).

Slomiany et al. discloses an apparatus and method for operating a gaming machine under the control of a processor operable in a basic mode and a bonus mode, selecting a basic game outcome from a plurality of basic game outcomes, the basic game outcomes including a start-bonus outcome, shifting operation of the processor from the basic mode to the bonus mode upon obtaining the start-bonus outcome, starting a bonus game, and selecting, one at a time, one or more of the selection elements in the bonus mode until encountering an end-bonus penalty, and

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shifting operation of the processor back to the basic game mode from the bonus mode. Slomiany et al. additionally discloses :

Regarding Claim 1:

- receiving a wager for the casino game in said normal play mode (basic play mode) (Column 3, lines 5-14 and 22-37);
- generating a game outcome in response to receiving the wager in normal play mode (Column 3, lines 22-50);
- initiating the free play mode (bonus play mode) when the game outcome matches a first game outcome (Column 3, lines 34-48, Column 6, lines 1-6, and Claim 12);
- continuing in said free play mode (bonus play mode) to play the casino game until the game outcome matches a second game outcome (end bonus penalty-bomb (30i or 30h)) which stops the free play mode and returns the casino game to the normal play mode (basic play mode) (Claim 12 and Figure 6).

Regarding Claim 2:

- continuing play of said casino game in said free play mode until a stop signal (end bonus penalty-bomb (30i or 30h)) generated by said casino game (Claim 12, Figure 6, and Column 7, lines 30-57).

Regarding Claim 5:

- using the symbols shown as the outcome of the base game (start bonus outcome) and the selection of at least one of them for starting an additional bonus game (Column 4, lines 34-48, Column 6, lines 1-6, and Claim 12).

Regarding Claims 6, 15, and 20:



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- initiating said normal play mode (basic play mode) of said casino game (Column 3, lines 5-14 and 22-37);
- entering said free play mode (bonus play mode) of said casino game from said initiated normal play mode (Column 3, lines 34-48, Column 6, lines 1-6, and Claim 12);
- enabling play of the casino game to remain in said free play mode for a variable number of plays (trials) of said casino game (Column 9, lines 23-39 and Claim 12); and
- exiting said free play mode of said casino game upon completion of said variable number of plays (Claim 12).

Regarding Claim 7:

- for a given casino game outcome, paying a multiplier award equal to the normal-play-mode award for said given casino game outcome multiplied by a multiplying factor (X1), for at least a portion of said plays of said casino game in said free play mode (Column 7, lines 12-29). In the bonus game, the first trial is guaranteed to be a successful trial. That is, the normal prize (multiple of one), is awarded for the first pig selected. Afterwards, bonus credits can be obtained by successfully selecting more pigs without selecting an end-bonus-penalty.

Regarding Claim 9:

- paying only said normal-play-mode award level for bonus game awards occurring in said free play mode (Column 7, lines 12-29 and Figure 8). In the bonus game, the first trial is guaranteed to be a successful trial. That is, the normal prize (multiple of

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one), is awarded for the first pig selected. The normal prize is additionally selected for at least the next two successful trials. Afterwards, bonus credits can be obtained by successfully selecting more pigs without selecting an end-bonus-penalty.

Regarding Claims 10 and 24:

- said initiating comprises receiving a wager from said player (Column 3, lines 5-14 and 22-37).

Regarding Claim 11:

- permitting said play of said casino game to remain in said free play mode until a randomly occurring triggering event (end bonus penalty-bomb (30i or 30h)) takes place (Claim 12 and Figure 6).

Regarding Claim 12:

- ending said play in said free play mode upon incurring an appearance of a stop symbol (end bonus penalty-bomb (30i or 30h)) in a game outcome during said free-play-mode play (Claim 12 and Column 7, lines 30-57).

Regarding Claim 13:

- selecting a free-play-mode value (select one of ten pigs having associated values attached) at random from a plurality of values (Figure 5).

Regarding Claim 14:

- randomly assigning each of a plurality of values to a different one of a plurality of player input devices (Figure 5 and Column 7, lines 1-47);
- activating a player input device of said player input devices having said free-play-mode value assigned thereto (Figure 5 and Column 7, lines 1-47).

Regarding Claim 16:

- randomly generating said particular game outcome from a plurality of possible game outcomes (Claim 12).

Regarding Claim 17:

- generating a game outcome for each play of the casino game in said free play mode (Claim 12);
- evaluating, after each said play of said casino game in said free play mode, whether said game outcome includes a signal operative to stop said free play mode (Claim 12); and
- ending said free play mode only if said stop signal is provided (Claim 12).

Regarding Claim 18:

- providing an at least substantially equal probability of inclusion of said stop signal in said game outcome for each said play of said casino game in said free play mode (Column 7, lines 1-47).

Regarding Claim 19:

- providing an identical probability of inclusion of said stop signal in said game outcome for each said play of said casino game in said free play mode (Column 7, lines 1-47).

Regarding Claim 21:

- adjusting said first probability and said second probability to control a house advantage of said casino game (Column 6, lines 65-67).

Regarding Claim 22:

- said first probability (0.007234) is at least substantially equal for all plays of said casino game in said normal play mode (Figure 10). The first probability will remain unchanged as long as the probability table is unmodified.

Regarding Claim 23:

- providing a variable number of consecutive plays (trials) of said casino game in said free play mode, between said entering and said exiting, among different instances of said free play mode (Claim 12).

Regarding Claims 25 and 29:

- a wager/award input/output for receiving a wager from a player to initiate said base/normal game (Column 3, lines 5-14 and 22-37);
- a player input operative to enable entry into said bonus game/free-play-mode from said initiated base/normal game (Column 3, lines 34-48, Column 6, lines 1-6, and Claim 12);
- a memory (48) for storing a stop signal indicative of a bonus-game-ending/free-play-mode-ending game outcome of said bonus/free-play-mode game (Figure 1b, Column 3, line 38-Column 4, line 64);
- a computer (40), connected to said wager/award input/output (38), said player input (42), and said memory (48), wherein said computer is operative to:
- provide at least one consecutive bonus/free-play-mode game outcome, said at least one consecutive bonus/free-play-mode game outcome being selected from a plurality of possible game outcomes (Claim 12 and Column 7, lines 12-29);

- determine whether a latest bonus/free-play-mode game outcome matches said bonus-game-ending/free-play-mode-ending game outcome (Claim 12), and
- end said bonus/free-play-mode game upon discovering a match between said latest bonus/free-play-mode game outcome and said bonus-game-ending/free-play-mode-ending game outcome, said computer generating said stop signal upon ending said bonus/free-mode-play game (Claim 12).

Regarding Claim 26:

- said base game is a normal-play-mode game in which a wager is received for each play of said base game (Column 3, lines 5-14 and 22-37).

Regarding Claim 27:

- said bonus game is a free-play-mode game in which play of said bonus game proceeds for free until said generation of said stop signal (Claim 12).

Regarding Claim 28:

- a game display (video display 24) operative to inform a player of said casino game of options for activation of said player input (Figures 1a, 1b, and Column 3, lines 5-21).

### *Claim Rejections - 35 USC § 103*

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slomiany et al. (U.S. 6,159,098).

Slomiany et al. discloses to one having ordinary skill in the art that as discussed above regarding claims 1, 2, 5, 6, 7, and 9-29. However, Slomiany et al. seems to lack explicitly stating:

Regarding Claim 8:

- the multiplying factor equals three.

However, Slomiany et al. does teach that additional bonus credits are provided for a number of successful trials in the bonus game. Game award multipliers are notoriously well known in the gaming arts. It would have been obvious at the time of applicant's invention to utilize game award multipliers, such as 3X, to enhance a player's award rather than providing additional bonus credit values. One would be motivated to do so because for each successful trial in the bonus game the player would obtain an additional game award multiplier making the bonus game much more exciting each time a selection is made.

### *Conclusion*

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Thomas et al. '309, Manship et al. '843, Bennett '977, and Frohm et al. '457 disclose gaming machines having basic and bonus games.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones  
Examiner  
Art Unit 3713

A handwritten signature in black ink that reads "Scott E. Jones". The signature is written in a cursive style with a large, stylized "S" and "J".

sej